

Claim 1 recites an individual authentication system that comprises “an individual authentication card . . . [that] has a function of collating the stored identification number with the identification number transmitted by the identification number input device.” The Examiner contends that this feature is disclosed by Teicher (newly cited). The Examiner alleges that it would have been obvious for one skilled in the art to combine the teachings of Teicher with Moussa and Dunn because it would “provide another user input required to access the system, increasing security” and “by collating the PIN directly on the smart card, making it impossible . . . for another device . . . to covertly obtain the PIN.” Applicant submits that the Examiner’s reasons for combining are not supported by the prior art.

In order to establish a *prima facie* case of obviousness the prior art must provide some suggestion or motivation for combining the references. See MPEP 2143. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP at 2100-131 quoting *In re Mills*, 916 F.2d 680. Applicants submit that one skilled in the art would not have combined the references as suggested by the Examiner because the prior art does not provide the motivation or suggestion and, in fact, teaches away from one another.

Moussa discloses that it would be desirable to use “a physical token which does not require electrical power to operate” or “require the user to enter data or otherwise interact with the physical token” (col. 1, lines 59-64). Moussa discloses that physical tokens, in which the system issues an electronic challenge to the physical token and the user interacts with the physical token, are “less secure than those which do not” (see col. 1, lines 20-46). Moussa

prefers the use of a login service 140 and an operating system 150 which are executed by a processor 110 (computer, see Fig. 1).

In direct contrast to Moussa, Teicher teaches authenticating a user by entering a PIN directly onto a smart card (physical token) and also teaches the use of a powered card (Fig. 11). In addition, Teicher teaches away from authenticating a PIN outside the smart card (such as with computers, see Figs. 9A and 9B) because such a system is less secure than interacting with the smart card (see generally, Background of the Invention and Summary of the Invention).

Dunn discloses a biometric input device such as a fingerprint device (col. 1, lines 57-57). Dunn teaches away from using both passwords and portable cards because of their unreliability (see col. 1, lines 31-56).

Applicant submits that the Examiner has cited three references that explicitly teach away from one another. Therefore, the Examiner's proffered reasons for combining could only have been reached through improper hindsight and with the aid of Applicant's own disclosure. Because the Examiner has not provided support in the prior art for combining the references, Applicant submits that the Examiner has not made a *prima facie* case of obviousness and requests that the rejection be withdrawn.

The Examiner has rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Moussa in view of Dunn, Teicher and Pearson et al. (US 5,991,408 ["Pearson"]). For at least the following reason, Applicant traverses the rejection.

Because one skilled in the art would not have combined at least Moussa, Teicher and Dunn for at least the reasons stated above and Pearson does not cure the deficient teachings of

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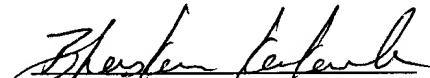
the cited prior art with respect to claim 1, Applicant submits that claim 5 is patentable at least by virtue of its dependency on claim 1.

**2. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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